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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,621

12/03/2004

Tatsuo Tsuneka

SAE-036

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/516,621	Applicant(s) TSUNEKA ET AL.	
	Examiner WILLIAM K. CHEUNG	Art Unit 1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: none.
 Claim(s) objected to: none.
 Claim(s) rejected: 6-11.
 Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
 See page 2.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/William K Cheung/
 Primary Examiner, Art Unit 1796
 March 4, 2008

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that it is unclear if teachings of Yamamoto et al. (col. 7, line 26-29) "the above-described components of the photosensitive resin composition are dissolved in any order and mixed in an appropriate solvent or component (D)" can include the processing order of claim 6. However, applicants fail to recognize that Yamamoto et al. (col. 7, line 26-29) teach that "any order" is suitable, which includes the order of applicants' claim 6.

Regarding applicants' argument that Yamamoto et al. discloses that solvent (ie., all solvent including water) is removed in the process, applicants fail to recognize that water is a non-solvent, and ether has a much lower boiling point and lower heat of vaporization as compared to water. Therefore, the examiner has a reasonable basis that the ethereal solvent can be removed without removing the water in the composition of Yamamoto et al. Regarding applicants' argument that claim 6 as written excludes non-recited components such as the hydrophilic polymer (B) of the composition of Yamamoto et al. that would be expected to affect the basic characteristics of the aqueous resin dispersion composition, applicants fail to submit any evidence to support such argument. Further, applicants must recognize that the specification as written fail to define what properties are considered the basic properties of the claimed process.

Regarding the argued "unexpected results" filed in the Declaration of May 22, 2006, applicants fail to recognize that Yamamoto et al. (col. 3, line 65) teach compositions comprising chlorinated polyethylene (component A), not chlorinated propylene ethylene copolymers used in the comparative examples in the declaration filed. Applicants must also recognize that the water taught in Yamamoto et al. is for dissolving component (B) hydrophilic monomers in dispersion, not chlorinated polyethylenes (component A) (col. 2, line 61-67). Further, the composition as taught in Yamamoto et al. (col. 2, line 61-66) clearly comprises hydrophobic component (A) and hydrophilic component (B), and the appropriate solvent of each the components taught. Therefore, in view of the reasons set forth above, the comparative data filed on May 22, 2006 clearly are not done according to the procedure of Yamamoto et al. and therefore the argued "comparative data" fail to show the criticality of the claimed invention.

Regarding applicants' argument that the amended claim 6 recites that the ethereal solvent is removed to obtain the aqueous resin dispersion, applicants must recognize that water is a non-solvent to chlorinated polyethylene. Chlorinated polyethylenes (hydrophobic component A) are typically soluble in ethereal solvents, chloroform, toluene, and benzene, not water. The water taught in Yamamoto et al. (col. 7, line 31) is for dissolving the hydrophilic component (B), which are clearly taught in Yamamoto et al. (col. 4, line 36-65). Regarding the claimed "dispersion" feature, applicants must recognize that when the hydrophobic component (A) and hydrophilic component (B) are mixed, it would result in the formation of a dispersion.

Regarding applicants' argument that the recitation "removing the ethereal solvent to obtain the aqueous dispersion" of claim 1 implies that all the ethereal solvent has been removed to obtain the aqueous dispersion, however, the claim does not support the argued "all" feature. Applicants must recognize that the removing part of the ethereal solvent or incomplete removal of the ethereal solvent can still result an aqueous dispersion because the water component will remain in the composition until most of the ethereal solvent component has been removed. Applicants must also recognize that the removal of the ethereal solvent does not mean the water component in the composition as taught in Yamamoto et al. is removed since water has a much higher heat of vaporization as compared to ethereal solvents.

In view of the reasons set forth above, the rejection issued on November 16, 2007 is maintained.